

012204

14230 U.S. PTO

PTO/SB/05 (08-03)

Approved for use through 07/31/2006. OMB 0651-0032

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UTILITY  
PATENT APPLICATION  
TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.

1256-00942

First Inventor

Hector F. DeLuca

Title

(20S)-1-Alpha-Hydroxy-2-Alpha-Methyl and  
2-Beta-Methyl-19-Nor-Vitamin D3 and Their Uses

Express Mail Label No.

EV383667504US

## APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

ADDRESS TO:

Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria VA 22313-1450

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)  
(Submit an original and a duplicate for fee processing)
2. ☐ Applicant claims small entity status.  
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 38]  
(preferred arrangement set forth below)
- Descriptive title of the invention
  - Cross Reference to Related Applications
  - Statement Regarding Fed sponsored R & D
  - Reference to sequence listing, a table, or a computer program listing appendix
  - Background of the Invention
  - Brief Summary of the Invention
  - Brief Description of the Drawings (if filed)
  - Detailed Description
  - Claim(s)
  - Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 1]
5. Oath or Declaration [Total Sheets 3]
- a. ☐ Newly executed (original or copy)
- b. ☒ Copy from a prior application (37 CFR 1.63(d))  
(for continuation/divisional with Box 18 completed)
- i. ☐ DELETION OF INVENTOR(S)  
Signed statement attached deleting inventor(s)  
name in the prior application, see 37 CFR  
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76

7. ☐ CD-ROM or CD-R in duplicate, large table or  
Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission  
(if applicable, all necessary)
- a. ☐ Computer Readable Form (CRF)
- b. Specification Sequence Listing on:
- i. ☐ CD-ROM or CD-R (2 copies); or
- ii. ☐ Paper
- c. ☐ Statements verifying identity of above copies

## ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & document(s))
10. ☐ 37 CFR 3.73(b) Statement ☐ Power of Attorney  
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☒ Information Disclosure ☒ Copies of IDS  
Statement (IDS)/PTO-1449 Citations
13. ☒ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)  
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)  
(if foreign priority is claimed)
16. ☐ Nonpublication Request under 35 U.S.C. 122  
(b)(2)(B)(i). Applicant must attach form PTO/SB/35  
or its equivalent.
17. ☐ Other: .....

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation☒ Divisional☐ Continuation-in-part (CIP)

of prior application No.: 10/127,180.....

Prior application information:

Examiner Sabiha Naim Qazi

Art Unit: 1616

For CONTINUATION OF DIVISIONAL APPS only; The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

## 19. CORRESPONDENCE ADDRESS



Customer Number:

26753

OR ☐

Correspondence address below

Name

Thomas M. Wozny

Address

Andrus, Sceales, Starke &amp; Sawall, LLP

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53202-4178

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Telephone

414-271-7590

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414-271-5770

Name (Print/Type)

Thomas M. Wozny

Registration No. (Attorney/Agent)

28,922

Signature



Date

January 22, 2004

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$ 770.00)**Complete if Known**

Application Number	
Filing Date	January 22, 2004
First Named Inventor	Hector F. DeLuca
Examiner Name	
Art Unit	
Attorney Docket No.	1256-00942

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit  
Account  
Number  
Deposit  
Account  
Name

01.2000

Andrus, Scales, Starke &amp; Sawall, LLP

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments☒ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	\$770
1002 340	2002 170	Design filing fee	
1003 530	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
<b>SUBTOTAL (1)</b>			<b>(\$ 770.00)</b>

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

Total Claims 6 -20\*\* = 0 X Fee from below = Fee Paid 0

Independent Claims 1 -3\*\* = 0 X Fee from below = Fee Paid 0

Multiple Dependent        = 0

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

**SUBTOTAL (2)** (\$ 0.00)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for <i>ex parte</i> reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 950	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1806 180	1806 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** (\$ 0.00)**SUBMITTED BY**

(Complete (if applicable))

Name (Print/Type)	Thomas M. Wozny	Registration No. (Attorney/Agent)	28,922	Telephone	414-271-7590
Signature		Date	January 22, 2004		

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

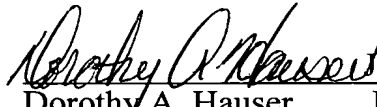
This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS

**SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Divisional Application of:	)	<u>CERTIFICATE OF EXPRESS MAILING</u>
Hector F. DeLuca	)	I hereby certify that this correspondence is
Rafal R. Sicinski	)	being deposited with the United States Postal
Pawel K. Grzywacz	)	Service with sufficient postage as
	)	EXPRESS MAIL in an envelope addressed
Title: (20S)-1 $\alpha$ -Hydroxy-2 $\alpha$ -Methyl	)	to: Commissioner for Patents, P.O. Box
and 2 $\beta$ -Methyl-19-Nor-Vitamin D <sub>3</sub>	)	1450, Alexandria, VA 22313-1450, on this
and Their Uses	)	22nd day of January, 2004. The Express
Attorney Docket: 1256-00942	)	Mail Label is EV383667504US.
	)	
<b>Parent Application Data:</b>	)	
Application No.: 10/127,180	)	 January 22, 2004
Filed: April 22, 2002	)	Dorothy A. Hauser Date
Examiner: Sabiha Naim Qazi	)	
	)	
Group Art Unit: 1616	)	
	)	
Title: (20S)-1 $\alpha$ -Hydroxy-2 $\alpha$ -Methyl	)	
and 2 $\beta$ -Methyl-19-Nor-Vitamin D <sub>3</sub>	)	
and Their Uses	)	

NOTIFICATION OF THE FILING OF A DIVISIONAL APPLICATION

Mail Stop: Divisional Application  
Commissioner of Patents  
Alexandria, VA 22313-1450

Sir:

This is a request for filing a divisional application, of pending prior Application No. 10/127,180, filed April 22, 2002, of Hector F. DeLuca, Rafal R. Sicinski and Pawel K. Grzywacz for (20S)-1 $\alpha$ -Hydroxy-2 $\alpha$ -Methyl and 2 $\beta$ -Methyl-19-Nor-Vitamin D<sub>3</sub> and Their Uses.

Applicants: Hector F. DeLuca et al  
Attorney Docket 1256-00942

1. I hereby verify that the attached papers are a true copy of what is shown in my records to be the above identified parent application, including the Oath or Declaration originally filed. No amendments referred to in the Declaration introduced new matter in the application.

2. The papers of the parent application, as filed, which are attached are as follows:

38 pages of specification  
6 claims (after entry of Preliminary Amendment attached hereto)  
1 page of abstract  
1 sheet of drawing (Figures 1 and 2)  
3 pages of Declaration and Power of Attorney

3. The filing fee is computed as indicated in the attached PTO Fee Transmittal (PTO/SB/17).

4. A check in the amount of \$770.00 accompanies this application to cover the filing fee pursuant to 37 C.F.R. §1.16. Kindly charge any additional patent filing or processing fees in this divisional application under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 01.2000. An additional copy of this Notification is enclosed.

5. An Information Disclosure Statement is enclosed.

6. A Preliminary Amendment is enclosed.

7. The prior application is assigned of record to Wisconsin Alumni Research Foundation of Madison, Wisconsin and the Assignment is effective to assign the present divisional application to Wisconsin Alumni Research Foundation. The Assignment was recorded on June 13, 2002, at Reel Frame Nos. 146-150.

Applicants: Hector F. DeLuca et al  
Attorney Docket 1256-00942

8. Address for Correspondence - Please address all correspondence to:


ANDRUS, SCEALES, STARKE & SAWALL, LLP  
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Milwaukee, Wisconsin 53202

Please address all telephone calls to:

Thomas M. Wozny  
(414) 271-7590

Respectfully submitted,

ANDRUS, SCEALES, STARKE & SAWALL, LLP

By   
Thomas M. Wozny  
Reg. No. 28,922  
(414) 271-7590

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